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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/865,841	05/30/1997	JAKOB NIELSEN	2860-059-P22	8979
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005				
			EXAMINER COBY, FRANTZ	
			ART UNIT 2171	PAPER NUMBER 22

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/865,841

Applicant(s)

NIELSEN, JAKOB

Examiner

Frantz Coby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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This is in response to the decision by the Board of Appeal and Interferences submitted on September 30, 2003 in which the decision of the Examiner to reject claims 1-18, 21-24, and 26 under 35 U.S.C. 102(e) is reversed. The decision of the Examiner to reject claims 19, 20 and 25 under 35 U.S.C. 102(e) is affirmed.

**Status of Claims**

Claims 1-26 are pending.

After further search and reconsideration of the present Application, the Examiner has found new reference (**U.S. Patent 5,995,979**) issued to Cochran that read on the reversed claims as well as on the affirmed claims.

In view of the new found reference, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

**Claims 1-26 are rejected as follows.**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Cochran U.S. Patent no. 5,995,979.

As per claim 1, Cochran discloses "a computer apparatus for information retrieval" by providing a plurality of computers connected in a network (See Cochran figure 1, components 720) including computer software that permit the accessing of data from a computer database (See Cochran Col. 5, lines 40-42). As to the claimed features of "a bus", this feature is primarily incorporated in the computers disclosed by Cochran since a bus is a set of hardware lines or conductors used for data transfer among the components of a computer system. Notice that "a processor" is inherent in a computer" because it the computational and control unit of a computer. As to the claimed limitations of "a communication interface connected to said bus", Cochran discloses that each computer (Figure 1 component 720) has memory space 717 and a monitor device 725. It would be apparent that each of the computers of Cochran includes an interface that connects pieces of hardware with the processor so that information can be moved from place to place. Cochran has shown the claimed limitations of "information storage" as a CD-ROM (See Cochran Col. 5, lines 39-41) and it is also apparent that the CD-ROM would be connected to a bus to properly function with the processor. As to a processor configured to "receive search queries" and "process those queries", Cochran provides mechanism such as computer software which permits the accessing of data from a computer database" (See Cochran Col. 5,

lines 40-41). In particular, claim 1 recites a processor "to provide a list of terms used in search queries presented over a period of time to be selectively added to information stored in information storage". Cochran discloses the aforementioned claimed limitations by providing a method for managing the presentation of search terms on a computer wherein multiple lists of search terms are displayed, a search is conducted based upon selected search terms from one or more of the multiple search lists, also, the records identified by the search is used to form new lists of search terms (See Cochran Abstract; Col. 4, lines 1-57; Figure 2 and corresponding text).

As per claims 2-3, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Cochran disclose the claimed limitations of "a term to be selectively added is added to a document of file as a meta-tag"; by allowing entry to be made in the lists; thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice that the lists of Cochran (See Cochran Figures 3-10b) are multi-element data structure that has a linear organization that allows elements to be added or removed. Thus, when updating the lists, entries are made in the multi-element data structure. The Applicant should duly note that a meta-tag is described in the specification (page 1, lines 11-12) as an entry in a meta-information section of a document or a file. As to the claimed feature of "a term to be selectively added is also added to an inverted index" Cochran achieved this limitation by providing lists of search terms where the lists can be updated (See Cochran Figures 3-10b). Thus, It would be apparent from Cochran's use of updating list

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that terms must be added to an inverted index to effectively create alternative locators for the search terms in the lists.

As per claim 4, Cochran "an information retrieval system" by providing a plurality of computers connected in a network (See Cochran figure 1, components 720) including computer software that permit the accessing of data from a computer database (See Cochran Col. 5, lines 40-42). In particular, Cochran discloses the claimed limitations of "a network"; "a plurality of users connected to said network" by providing a computer communication network (See Cochran Figure 1). Further, Cochran discloses the claimed features of "at least one server connected to said network, said sever providing search access to a plurality of documents and files stored on said server in response to search queries submitted by users" (See Cochran Col. 5, line 65-Col. 7, line 4). Last, Cochran discloses the claimed limitations of "said server configured to provide a list of terms used in search queries over a period of time to be selectively added to information stored in information storage" by providing a method for managing the presentation of search terms on a computer wherein multiple lists of search terms are displayed, a search is conducted based upon selected search terms from one or more of the multiple search lists, also, the records identified by the search is used to form new lists of search terms (See Cochran Abstract; Col. 4, lines 1-57; Figure 2 and corresponding text).

As per claims 5-6, most of the limitations of these claims have been noted in the rejection of claim 4. Applicant's attention is directed to the rejection of claim 4 above. In addition, Cochran disclose the claimed limitations of "a term to be selectively added is added to a document of file as a meta-tag"; by allowing entry to be made in the lists; thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice that the lists of Cochran (See Cochran Figures 3-10b) are multi-element data structure that has a linear organization that allows elements to be added or removed. Thus, when updating the lists, entries are made in the multi-element data structure. The Applicant should duly note that a meta-tag is described in the specification (page 1, lines 11-12) as an entry in a meta-information section of a document or a file. As to the claimed feature of "a term to be selectively added is also added to an inverted index" Cochran achieved this limitation by providing lists of search terms where the lists can be updated (See Cochran Figures 3-10b). Thus, It would be apparent from Cochran's use of updating list that terms must be added to an inverted index to effectively create alternative locators for the search terms in the lists.

As per claim 7, most of the limitations of this claim have been noted in the rejection of claims 1 and 4 above. In addition, Cochran discloses the claimed feature of "providing an element for storing a list of queries" and "an element for storing a list terms" by providing memory spaces for retaining search request (See Cochran Col. 6, lines 40-52). Also, Cochran discloses the claimed limitations of "providing an element for selecting" (See Cochran Col. 7, lines 48-54). Last, Cochran discloses the claimed

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limitations of "processing each term of said portion for selectively addition to documents or files stored in said systems as a meta-tag" by allowing entry to be made in the lists; thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice that the lists of Cochran (See Cochran Figures 3-10b) are multi-element data structure that has a linear organization that allows elements to be added or removed. Thus, when updating the lists, entries are made in the multi-element data structure. The Applicant should duly note that a meta-tag is described in the specification (page 1, lines 11-12) as an entry in a meta-information section of a document or a file.

As per claims 8-10, most of the limitations of these claims have been noted in the rejection of claims 7 and 4 above. In addition, Cochran discloses the claimed feature of "presenting the term to a user together with at least identifiers of a number of documents or files stored in said system containing said term; presenting the term to a user together with at least portions of a document identified by one of said identifiers" (See Cochran Col. 7, line 10-Col. 9, line 59); "said term is presented to a user with portions of a document in a graphical user interface having a user activatable function for adding a term to said document as a meta-tag" (See Cochran Figures 3a-9d and corresponding text).

As per claims 11-12, most of the limitations of these claims have been noted in the rejection of claim 7. Applicant's attention is directed to the rejection of claim 7 above. In addition, Cochran disclose the claimed limitations of "providing an element for



selectively adding said term to said document as a meta-tag"; by allowing entry to be made in the lists; thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice that the lists of Cochran (See Cochran Figures 3-10b) are multi-element data structure that has a linear organization that allows elements to be added or removed. Thus, when updating the lists, entries are made in the multi-element data structure. The Applicant should duly note that a meta-tag is described in the specification (page 1, lines 11-12) as an entry in a meta-information section of a document or a file. As to the claimed feature of "providing an element for adding information about the term added to said document as a meta-tag in an inverted index" Cochran achieved this limitation by providing lists of search terms where the lists can be updated (See Cochran Figures 3-10b). Thus, It would be apparent from Cochran's use of updating list that terms must be added to an inverted index to effectively create alternative locators for the search terms in the lists.

As per claim 13, all the limitations of this claim have been noted in the rejection of claims 1-12. Namely, "providing an element for storing" and "providing an element for adding". It is therefore rejected as set forth above.

As per claim 14, all the limitations of this claim have been noted in the rejection of claims 1-12. Namely, "providing and element for generating a term", "providing an element for generating a list" and using the list and the term for adding to documents containing those terms as a meta-tag. It is therefore rejected as set forth above.

As per claims 15-17, all the limitations of these claims have been noted in the rejection of claims 14 as well as claims 2-3 including terms to be added as meta-tag. They are therefore rejected as set forth above.

As per claims 18-26, most of the limitations of these claims have been noted in the rejection of claims 1-12. In addition, Cochran discloses sorting query terms (See Cochran Figure 3D and corresponding text); eliminating noise words or stop words (Figure 3c and corresponding text). Also, claims 18-26 set forth features that are inherent to carry out the invention as detailed in the analysis above. Namely, providing an element for extracting terms used in search query is inherent in a database since the primary purpose of submitting a query to a database is to extract information associated with the submitted query. Presenting those terms to said server is also inherent since a query result must be presented to a user when a query is submitted to indicate to the user whether any document was found according the submitted query. As to a computer program product, Cochran provides apparatus, method as well as computer software for implementing the invention (See Cochran Title; Col. 5, lines 40-42).

Claims 19-20 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Brunner et al. U.S. Patent no. 5,550,971.

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As per claims 19-20 and 25, Brunner et al. teaching of a database management system with adaptive user interface reads on the claimed features of "providing an element for extracting terms and presenting those terms to a user; providing an element for identifying a document containing a term; determining if the document contains subject matter related to said term; and providing an element for adding said term to said document as a meta-tag if it does" (See Brunner Abstract; and Col. 2, line 45-Col. 3, line 22).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cochran et al. U.S. Patent no. 4,879,648 discloses a search system which continuously displays search terms during scrolling and selections of individually displayed data sets.

Cochran et al. U.S. Patent no. 5,768,581 discloses apparatus and method for selecting records from a computer database by repeatedly displaying search terms from multiple list identifiers before either a list identifier or a search term is selected.


Cochran et al. U.S. Patent no. 5,206,949 discloses database search and record retrieval system which continuously displays category names during scrolling and selection of individually displayed search terms.

Sullivan et al. U.S. Patent no. 5,956,711 discloses database system which restricted keyword list and bi-directional keyword translation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 703 305-4006. The examiner can normally be reached on Monday - Friday from 10:30AM -10:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703 308 1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Frantz Coby  
Primary Examiner  
Art Unit 2171

January 29, 2004

  
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